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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,159	11/27/2001	James R. McCarthy	PH-7345-A	1709

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 01/14/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/995,159

Applicant(s)
McCarthy

Examiner
Venkataraman Balasubramanian

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Claims 1-18 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, drawn to compound of formula shown in claim 1 where A= N and B= N and method of use, classified in class 544, subclass 212, class 514 subclass 245.
- II. Claims 1-3, drawn to compound of formula shown in claim 1 where A= N, B= CR, and method of use, classified in class 544, subclass 211, class 514 subclass 246.
- III. Claims 1-3, drawn to compound of formula shown in claim 1 where A= CR B= N and method of use, classified in class 544 , subclass 281, class 514, subclass 258 .
- IV. Claims 1-3, drawn to compound of formula shown in claim 1 where A and B are CR, classified in class 544, subclass 326, class 514, subclass 258.
- V. Claims 4-6, drawn to compound of formula shown in claim 4 where either A or B or C=nitrogen and the other two = CR and method of use, classified in class 546, subclass 272.7, class 514, subclass 303.
- VI. Claims 4-6, drawn to compound of formula shown in claim 4 where A= N, B= CR and C= N, classified in class 544, subclass 280, class 514, subclass 548.

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- VII. Claims 7-9, drawn to compound of formula shown in claim 7 where A= N and B or C= N , the other CR, classified in class 544 , subclass 256, class 514, subclass 258.
- VIII. Claims 7-9, drawn to compound of formula shown in claim 7 where A= N and B= CR and C= CR, classified in class 544, subclass 279, class 514, subclass 258.
- IX. Claims 7-9, drawn to compound of formula shown in claim 7 where A= CR and B or C= N, the other CR, classified in class 544, subclass 236, class 514, subclass 248.
- X. Claims 7-9, drawn to compound of formula shown in claim 7 where A= CR, B= CR and C=CR and method of use, classified in class 546, subclass 113, class 514, subclass 300.
- XI. Claims 10-12, drawn to compound of formula shown in claim 10 where A= N, classified in class 544, subclass 256, class 514, subclass 258.
- XII. Claims 10-12, drawn to compound of formula shown in claim 10 where A= CR, and method of use, classified in class 544, subclass 279, class 514, subclass 258,.
- XIII. Claims 13-15, drawn to compound of formula shown in claim 13 and method of use, classified in class 546, subclass 122, class 514, subclass 300.
- XIV. Claims 13-15, drawn to compound of formula shown in claim 13 and method of use, classified in class 546, subclass 134, class 514, subclass 311.
- XV. Claims 16-18, drawn to compound of formula shown in claim 16 and method of use, classified in class 548, subclass 302.7, class 514, subclass 393.

The inventions are distinct, each from the other because of the following reasons:

Inventions of group I -XIII are independent and distinct from each other because they are directed to dissimilar compounds with varying cores such as bicyclotriazines with or without another nitrogen in the bicyclo ring versus bicyclopymidines with or without another nitrogen in the bicyclo ring versus bicylodiazines with three or more nitrogens versus benzofused imidazoles versus naphthyridines versus quinoline . Consequently, the groups have different classifications and require separate prior art searches. Art which may render obvious or anticipate one of the groups would not necessarily do the same for the other group. Each can support a patent as the compounds of each group are capable of being utilized alone not in combination with other members listed in the Markush group.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

In view of distinct nature of the inventions, a written restriction is set forth in writing.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on weekdays from 8.30 AM to 5.00 PM.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

V. Balasubramanian
Venkataraman Balasubramanian

1/13/2002